

11. (New) Protective hood according to claim 5, wherein the coating weight of the coating material lies between 20 and 40 g/cm².

12. (New) Protective hood according to claim 1, wherein the support material and/or the coating material contains a UV stabilizer or a flame-protection agent.

REMARKS

No claims have been canceled herein. Claims 1-9 have been amended herein. New claims 10-12 have been added herein. Therefore, claims 1-12 are under active consideration.

Claims 1-9 stand objected to “because of the following informalities: These claims contain, or depend on a claim, which contains the word ‘characterized.’ This term can introduce a question of scope. Applicant is requested to replace this word with ‘comprising’ or ‘wherein,’ as the case may be.”

Without acquiescing in the propriety of the objection, Applicant has amended the claims so that they no longer recite the word “characterized.” Accordingly, the objection has been overcome and should be withdrawn.

Claims 1-9 stand rejected under 35 U.S.C. 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” In support of the rejection, the Patent Office recites the following:

Regarding claim 1, the phrase “and the like” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “or the like”), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 1, the phrase “particularly for” renders the claim indefinite because it is unclear whether the limitation(s)

following the phrase are part of the claimed invention. See MPEP §2173.05(d).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation "between 12 and 200", and the claim also recites "between 50 and 90", which is the narrower statement of the range/limitation. Also, claim 5 recites the broad recitation "10 and 150" and the narrower range "20 and 40." Also, claim 7 recites the broad recitation "additives" and the narrower range "UV...agent."

Regarding claim 9, the phrase "namely for" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

With respect to claim 1, Applicant has removed the phrase "and the like" and has deleted the word "particularly." With respect to claims 4, 5 and 7, Applicant has deleted the narrower ranges and limitations. With respect to claim 9, Applicant has removed the phrase "namely for."

Accordingly, the foregoing rejection has been overcome and, therefore, should be withdrawn.

Claims 1-2 and 6-8 stand rejected under 35 U.S.C. 102(b) "as being anticipated by Tsutsumi et al (5223311)." In support of the rejection, the Patent Office states the following:

Tsutsumi is concerned with the creation of composite laminate used in automobiles and industrial materials (col. 3, lines 12-15). Said laminate comprising an ethylene butyl acrylate

copolymer film (col. 10, lines 29-30) extrusion coated (col. 8, lines 50-55) to a nonwoven polypropylene fabric (col. 11, lines 15-20 and col. 12, lines 15-17).

Said film having a butyl acrylate content between 1 to 40% (col. 4, lines 6-10 and 58-61).

Tsutsumi discloses the use of colorants (col. 13, lines 61-69).

Tsutsumi discloses the use of flame retardants (col. 13, lines 31-40).

Tsutsumi does not require plasticizers or solvents.

Applicant respectfully traverses the foregoing rejection. Claim 1, from which claims 2 and 6-8 depend, has been amended herein to be more definite and now recites a “[p]rotective hood for automobiles comprising a composite material with a support material of nonwoven polypropylene and a coating material of a thermoplastic copolymer, wherein said coating material is comprised of an ethylene-butyl acrylate copolymer and wherein said coating material is introduced onto the support material by means of extrusion coating.”

Applicant respectfully submits that claim 1 is neither anticipated by nor rendered obvious over Tsutsumi et al. for at least the reason that Tsutsumi et al. does not teach or suggest a protective hood for automobiles. The principal thrust of Tsutsumi et al. is the disclosure of a laminate which is well-suited for use as a wrapping or packaging material for foods. While there is a passing reference in Tsutsumi et al. to using its laminate for “automotive materials,” there is no disclosure of using the laminate as a “protective hood for automobiles,” and there is no reason, given the vague and open-ended nature of the reference in Tsutsumi et al. to “automotive materials,” why one of ordinary skill in the art would have understood Tsutsumi et al. to refer to or to provide any

meaningful direction leading a person of ordinary skill in the art to use the material as a protective hood for automobiles.

Claim 2, which recites that “the ethylene-butyl acrylate copolymer has a butyl acrylate content of 17 wt. %” is further distinguishable over Tsutsumi et al. for the reason that Tsutsumi et al. does not teach a butyl acrylate content of 17 wt %. The Patent Office is apparently relying on the alleged teaching of a broad range that supposedly encompasses the claimed limitation as constituting an anticipation. This is clearly contrary to well-established law. The broad range in question neither teaches nor suggests the claimed limitation.

Accordingly, for at least the above reason, the foregoing rejection should be withdrawn.

Claims 3-5 and 9 stand rejected under 35 U.S.C. 103(a) “as being unpatentable over Tsutsumi et al (5223311).” In support of the rejection, the Patent Office states the following:

Tsutsumi teaches the use of nonwoven fabrics, but is silent with respect to the means of bonding said fabric. The examiner takes official notice that it is common and well known in the art to bond nonwoven fabrics by thermal bonding. As such, it would have been obvious to a person having ordinary skill in the art to utilize thermal bonding. Such a modification would have been motivated by the desire to create a stronger fabric with a common well-known process. The examiner notes that the facts asserted to be common and well-known are capable of instant and unquestionable demonstration as being well-known. To adequately traverse such a finding, an applicant must specifically point the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.

Tsutsumi is silent with respect to the basis weight of the fabric and the amount of the coating. It would have been obvious to a person having ordinary skill in the art to alter the basis weight of the fabric and the amount of coating, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The skilled

artisan would have been motivated to vary the basis weight of the fabric and the amount of coating by the desire to render the laminate suitable for various end use applications.

In response to applicant's limitation of a "protective hood," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant respectfully traverses the foregoing rejection. Claims 3-5 depend from claim 1. Claim 1 is patentable over Tsutsumi et al. for at least the reasons above. Therefore, claims 3-5 are patentable over Tsutsumi et al. based at least on their respective dependencies.

In addition, with respect to claim 3, Applicant respectfully traverses the examiners's taking of official notice with respect to the issue of thermal bonding. MPEP 2144.03 requires that, where an examiner takes official notice, "[t]he examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." In the present case, the examiner has not provided a single factual finding to support his conclusion of common knowledge. Instead, all that the examiner has done in the instant case is to draw a conclusion and then to support the conclusion with mere conjecture about what one would have been motivated to do. Given that the examiner has not alleged any facts in support of his conclusion, there are no facts for Applicant to contradict.

Moreover, with respect to claims 4 and 5, Applicant respectfully submits that there is no basis for the claimed ranges. The Patent Office has not explained why one of ordinary skill in the art would have been motivated to make the changes necessary to arrive at the claimed ranges. Stating

that the motivation is a “desire to render the laminate suitable for various end use applications” is far too vague a motivation to provide any meaningful direction.

Claim 9 is patentable over Tsutsumi et al. for at least the same types of reasons given above for claim 1.

With respect to the Patent Office’s contention that Tsutsumi et al. teaches “structure...capable of performing the intended use” of a “protective hood,” Applicant respectfully disagrees. A protective hood for automobiles must have a shape or form that permits it to serve its purpose of protecting an automobile or an automobile part. The laminate of Tsutsumi et al. does not necessarily inherently have such a form or shape, but rather, would presumably have to be modified in some way in order to serve such a purpose. Applicant notes that the instant claims are not directed to “a composite material suitable for use as a protective hood for automobiles,” but rather, are directed to a “protective hood for automobiles” (or, in the case of claim 9, a “protective hood for automobile parts”). There is no basis for assuming that the laminates of Tsutsumi et al., as they are, are suitable for use as protective hoods for automobiles or for automobile parts.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is

required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 5, 2003



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MARKED-UP AMENDED CLAIMS 1-9

1. (Amended) Protective hood[, particularly] for automobiles[, machines and the like, comprised of] comprising a composite material with a support material of nonwoven polypropylene and a coating material of a thermoplastic copolymer, [characterized by the fact that the] wherein said coating material is comprised of an ethylene-butyl acrylate copolymer and wherein said coating material is introduced onto the support material by means of extrusion coating.

2. (Amended) Protective hood according to claim 1, [further characterized in that] wherein the ethylene-butyl acrylate copolymer has a butyl acrylate content of 17 wt. %.

3. (Amended) Protective hood according to claim 1, [further characterized in that] wherein the support material is a filament nonwoven material, whereby the nonwoven material is bonded by means of a thermal bonding.

4. (Amended) Protective hood according to claim 1, [further characterized in that] wherein the basis weight of the support material amounts to between 12 and 200 g/cm²[, preferably between 50 and 90 g/cm²].

5. (Amended) Protective hood according to claim 1, [further characterized in that] wherein the coating weight of the coating material lies between 10 and 150 g/cm²[, preferably between 20 and 40 g/cm²].

6. (Amended) Protective hood according to claim 1, [further characterized in that] wherein the support material and/or the coating material are colored.

7. (Amended) Protective hood according to claim 1, [further characterized in that] wherein the support material and/or the coating material contains additives[, particularly a UV stabilizer or a flame-protection agent].

8. (Amended) Protective hood according to claim 1, [further characterized in that] wherein the coating material is free of plasticizers and solvents.

9. (Amended) Protective hood [according to any one of the preceding claims, namely a protective hood for automobiles or] for automobile parts comprising a composite material with a support material of nonwoven polypropylene and a coating material of a thermoplastic copolymer, wherein said coating material is comprised of an ethylene-butyl acrylate copolymer and wherein said coating material is introduced onto the support material by means of extrusion coating.